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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,698	07/20/2001	Isao Sakata	2201/49996	8657

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EXAMINER

JONES, DAMERON L

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 07/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/889,698

Applicant(s)

SAKATA ET AL.

Examiner

D. L. Jones

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 9-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12-14 is/are allowed.
- 6) ☒ Claim(s) 9-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **ACKNOWLEDGMENTS**

1. The Examiner acknowledges receipt of Paper No. 7, filed 5/1/03, wherein claims 10 and 13 were amended.

**Note:** claims 9-14 are pending.

## **RESPONSE TO APPLICANT'S AMENDMENT/ARGUMENTS**

2. The Applicant's arguments filed 5/1/03 (Paper No. 7) to the rejection of claims 9-11 and 13 made by the Examiner under 35 USC 102 and/or 112 have been fully considered and deemed persuasive-in-part for the reasons set forth below.

### **112 Rejections**

The 112, second paragraph, rejections are WITHDRAWN for reasons of record in Applicant's response.

### **102 Rejections**

The rejection of claims 9-11 under 35 USC 102(b) as being anticipated by Sakata et al (JP 09124652) is MAINTAINED for reasons of record in the office action mailed 2/3/03, Paper No. 6, and those set forth below.

Applicant asserts that Sakata et al teach their porphyrin compound as a mixture of position isomers and that the mixture is useful for photodynamic treatment and diagnosis of cancer. Thus, since there is no teaching of any single isomer, Sakata et al do not read on the instant invention.

First, it should be noted that claim 9 reads on a compound. Claim 10 reads on a composition comprising the compound of claim 9 and claim 11 reads on a method of using the composition of claim 10. Thus, since the compound of claim 9 is disclosed by

Sakata et al, whether one of the isomers or not, the reference discloses the compound. As for the composition, it should be noted that a composition comprises one or more components. Hence, since the mixture contains the specific compound being claimed by Applicant and a carrier, the limitations of claim 10 are fulfilled. In addition, it should be noted that the composition is administered in the treatment/diagnosis of cancer. Thus, the limitation of claim 11 are fulfilled.

Applicant is reminded that a novel useful compound which is isomeric with a compound of the prior art is unpatentable unless it possesses some unobvious or unexpected beneficial property not possessed by the prior art compound (*In re Norris*, CCPA 1950, 179 F2d 970). Likewise, Applicant is reminded that an optically active isomer is unpatentable over a prior art racemate or optical isomer of opposite rotation in the absence of unexpected or unobvious beneficial properties (*In re Adamson et al*, CCPA 1960, 275 F2d 952).

#### **ALLOWABLE CLAIMS**

3. Claims 12-14 are allowable over the prior art of record for reasons of record in the office action mailed 2/3/03, Paper No. 6.

#### **COMMENTS/NOTES**

4. Another copy of Sakata et al (JP 09124652) is being mailed with this office action.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (703) 308-4640. The examiner can normally be reached on Mon.-Fri. (alternate Mon.), 6:45 a.m. - 4:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on (703) 308 - 2927. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

A handwritten signature in black ink, appearing to read 'D. L. Jones', is positioned above the printed name.

D. L. Jones  
Primary Examiner  
Art Unit 1616

July 8, 2003